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| 207 7590 01/05/2010 WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,928

Applicant(s)

GAGNEBIN, ROCK A.

Examiner

SHAWN M. BRADEN

Art Unit

3781

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8, 9, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8, 9, 20, 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 recites the limitation "said vacuum-producing device" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20,21,2-6,8,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (USPN 6,000,571) in view of Gray (USPN 7,273,155).

Brooks discloses the invention substantially as claimed as follows:

With respect to claim 20, a container having a tubular wall (14) and an upper opening thereto through a rim (15) of said wall ~~and a closed bottom (13)~~; a liner (12) having a tubular wall (17) ~~and having a top opening at a rim (22) of said wall and a closed bottom~~ (16) and disposed for placement in said container (11) through the opening of the container; said liner adapted for receiving a trash bag (31) through the opening of said liner; said liner dimensioned for insertion within said container with said liner opening in a fixed relation to said container opening and to thereby form an annular space (19)

between said liner wall and said container wall; said liner wall having a plurality of apertures (23,24).

3. With respect to claim 21, a liner (12) for a vacuum operated a tubular wall (17) and an upper opening thereto through a rim (22) of said wall and a closed bottom (16), an aperture through one of said container wall and bottom (24), and means for withdrawing air through the aperture (col 4 line 25-28 describes the air movement), said liner comprising: a tubular wall (12) and having a top opening at a rim (22) of said wall thereof and a closed bottom (16) and disposed for placement in said container through the opening of said container; said liner adapted for receiving a trash bag (31) through the opening of said liner; said liner dimensioned for insertion within said container with said liner opening in a fixed relation to said container opening and to thereby form an annular space (19) between said liner wall and said container wall from a location proximate to the opening; said liner wall having a plurality of apertures (23,24)

4. With respect to claim 8, Brooks shows comprising a perforated container lid (30), the container further including a closed container bottom (13) and a container flange (the upper edge of 15 meets the structure and recitation of flange) extending around an the opposite end of the tubular wall opposite the closed bottom (13); and the closed liner bottom (16) closing one end of said liner wall, said liner bottom spaced from said container closed bottom to define the annular space (fig. 2) a liner flange (21) provided on the rim of the opposite end of said liner wall from said liner bottom (16), the said liner flange structured and arranged to engage the container flange (rim of 15) for removably

receiving the container lid and wherein said means for withdrawing air is mounted on said container closed bottom (fig. 4).

5. With respect to claim 9, Brooks shows a perforated container lid (30), the container further including a container flange (rim of 15) extending around an end of said tubular container wall opposite a closed bottom end (13), and said liner further including a liner flange (21) on the rim, said liner wall spaced from said tubular wall to define said annular space (19) and said liner flange structured and arranged to engage said container flange (rim of 15) for removably receiving said container lid (30).

However Brooks does not disclose said liner wall having a plurality of apertures around and down its tubular wall from a location proximate said opening to a location proximate said closed bottom, said openings communicating from the interior of said liner to said annular space when said liner is inserted into said container, said at least one opening plurality of apertures comprises a plurality of elongated openings provided in spaced apart parallel relationship.

Martin teaches said liner wall having a plurality of elongated openings (15) extending in a direction between said rim and bottom of the container (claims 2,4) provided in spaced apart parallel (claim 6) relationship around and down its tubular wall from a location proximate said opening to a location proximate said closed bottom, said openings communicating from the interior of said liner to said annular space when said liner is inserted into said container; in the same field of endeavor for the purpose of ventilation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a plurality of elongated openings provided in spaced apart relationship as taught by Martin to the liner wall of Brooks in view of Gray in order to forcefully remove air pockets from the sidewall of a flexible bag liner in a trash receptacle.

However Brooks does not disclose an exhaust aperture through one of said contained wall and bottom; and means for withdrawing air from said annular space through the apertures through said exhaust aperture wherein air pressure is reduced in said annular space and the trash bag is forcefully deployed against and down said liner wall responsive to operation of said air withdrawing means..

Gray teaches (fig. 10) an exhaust aperture (94) through the container or one of said contained wall and bottom; and means for withdrawing air (a fan 95) from said annular space through the apertures through said exhaust aperture wherein air pressure is reduced in said annular space and the trash bag is forcefully deployed against and down said liner wall responsive to operation of said air withdrawing means (col 2 line 50-55), Grey also shows closed bottoms of the container and liner in the same field of endeavor for the purpose of removing space between the bag and the liner of a trash receptacle.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add an air removal mean to the bottom (claim 5) or side (claims 3,9) of the container as taught in various embodiments of Gray to the container of Brooks in view of Martin in order to remove air pockets in the bag liner of a trash receptacle.

Response to Arguments

6. Applicant's arguments filed 09/11/2009 have been fully considered but they are not persuasive. In response to applicant's amended claims, please see the amended rejection above.

In response to applicant's arguments

"For example, Brooks teaches a trash receptacle having an inner portion (12) and an outer portion (II). The Examiner incorrectly provides that Brooks does not teach a plurality of apertures. On the contrary, Brooks teaches a plurality of apertures 24 in the inner base (16) of the inner portion (12) and vent holes (28) in the depression (25). The stated purposes of these apertures (24) and vent holes (28) are, respectively, for easy removal of the trash bag and to introduce a scent into the inner portion (12). See, e.g., Brooks, col. 4, lines 23-30 and lines 56-58."

7. Applicant is not treating the claims as a whole, the claim language reads " a plurality of apertures around and down its tubular wall" the more complete structure was addressed in the rejection and applicant's argument is not persuasive.

In response to applicant's arguments

"The invention as claimed solves a problem having to do with inserting a trash bag, not removing it. Furthermore, the invention as claimed draws air out of the inner liner rather than to introduce (scented) air into the liner. Consequently, ~old elements" are not performing the same function as taught by Brooks and do not yield what one would expect by reading Brooks."

8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

9. In response to applicant's argument that "the invention as claimed solves a problem having to do with inserting a trash bag, not removing it", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

10. In response to applicant's arguments
"Here again, the invention as claimed solves a problem having to do with inserting a trash bag, not removing it. Furthermore, the invention as claimed forcefully draws air out of the inner liner to make the trash bag deploy against the inner wall of the line, whereas the trash bag in Martin is "deployed" only when and as it is filled with garbage. Consequently, ~old elements" are not performing the same function as taught by Martin and Brooks and do not yield what one would expect by reading Martin and Brooks."

11. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., forcefully draws air out) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. In response to applicant's next argument,

Finally, the Examiner suggests combining Gray with Brooks and Martin. Gray, like Brooks teaches providing an inner receptacle (12) in which a plurality of vent holes (20, 20A) are disposed solely in a

bottom wall (16). A fan (95) draws air out of the inner receptacle (12) via the vent holes (20, 20A) to deploy the trash bag (1). As shown in Gray's drawings, once the inner receptacle is inserted in the outer base member, the outer walls of the inner receptacles and the inner walls of the outer base members are in a tight interference fit. Indeed, after insertion and during operation, the only air cavity is that formed between the two bottom walls (13 and 16). In short, Gray teaches drawing air out of the bottom of the inner receptacle and inside the inner receptacle. Adding apertures to the Gray side walls would be senseless because the outer walls of the inner receptacles and the inner walls of the outer base members operate to form a seal preventing air to be withdrawn. However, as accompanying Figs. 6a-6c demonstrate, by drawing air from the bottom only, this often results in unsatisfactory results. Nevertheless, under the KSR inquiry, adding a plurality of apertures to the walls of an inner liner would result in ~old elements" performing an entirely different function that that for which they were provided in Martin. Moreover, as shown in accompanying Figs. 7a-7d, the combination yields a more satisfactory result that uses the air pressure on the inner wall of the liner to prevent the vacuum from drawing the plastic bag down along the inner wall. This result could not and would not have been foreseen by or obvious to those skilled in the art. Accordingly, the Applicant believes that independent claims 20 and 21 and all claims depending therefrom satisfy all of the requirements of 35 U.S.C. § 101, et seq. -- especially § 103(a) -- and are in condition for allowance. Withdrawal of the grounds for rejection is respectfully requested.

Examiner is encouraged to contact the undersigned to work out any differences which may be seen as impeding the allowance of this application.

13. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

14. Examiner views all of the references that have been applied to perform a very similar function, the function of containing a trash bag liner. Applicant's argument that they perform entirely different functions is not persuasive.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAWN M. BRADEN whose telephone number is (571)272-8026. The examiner can normally be reached on Mon-Friday 9-6:30 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571)272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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